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09/634,612	08/05/2000	Ronald John Rosenberger		2637

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[REDACTED]
EXAMINER

MYHRE, JAMES W

[REDACTED]
ART UNIT PAPER NUMBER

3622

DATE MAILED: 06/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/634,612	Applicant(s) Rosenberger
Examiner James W. Myhre	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Apr 15, 2003
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 60-145 is/are pending in the application.
- 4a) Of the above, claim(s) 100-102 and 143-145 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 60-99 and 103-142 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) Other: _____

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DETAILED ACTION

Response to Amendment

1. The amendment filed on April 15, 2003 under 37 CFR 1.131 is sufficient to overcome the Bucci (5,655,089) reference by canceling all of the rejected claims and adding claims 60-145.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 60-99 and 103-142, drawn to providing health-related reminders, tips or suggestions to cardholders with their billing statements, classified in class 705, subclass 14.
 - II. Claims 100 and 143, drawn to printing personal messages onto financial cards, classified in class 705, subclass 14.
 - III. Claims 101, 102, 144, and 145, drawn to receiving information pertaining to the death or injury of a cardholder, classified in class 705, subclass 4.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as personalized messages may be

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printed on financial cards without providing health-related reminders, tips, or suggestions with the cardholder's billing statement. See MPEP § 806.05(d).

4. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as information pertaining to the death or injury of a cardholder may be received without providing health-related reminders, tips, or suggestions with the cardholder's billing statement. See MPEP § 806.05(d).

5. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as information pertaining to the death or injury of a cardholder may be received without printing personalized messages on the financial card. See MPEP § 806.05(d).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. The Examiner notes that the Applicant has previously elected the invention of Group I and has received an action thereon. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 100-102 and 143-145 are

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withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

8. The amendment filed on April 15, 2003, canceled Claims 33 and 34, therefore, rendering moot the rejection of these claims under 35 U.S.C. 112, second paragraph, in paragraph 3 of the previous office action (paper number 9). Therefore, the Examiner hereby withdraws that rejection.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 64 and 107 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims include the limitation that the “reminders, tips or suggestions comprise non-health related topicalities”. However, the parent claims, Claims 60 and 103, are explicitly directed toward conveying health awareness tools, which are comprised of “reminders, tips, or suggestions for any health-related topic, health-related preventive measure, medical check-up, medical exam, or medical procedure”. Thus, Claims 64 and 107 are in direct contradiction to the

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parent claims. It is unclear how one skilled in the art could provide reminders, tips or suggestions about non-health related topic which are also “for any health-related topic”.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 60-99 and 103-142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bucci (5,655,089) in view of Byerly et al (6,067,524).

Claims 60, 98, 99, 103, 141, and 142: Bucci discloses a system and method for providing personalized messages with billing statements, comprising:

- a. Receiving and storing transaction data pertaining to the end user (col 2, lines 51-63);
- b. Providing one or more targeted messages to the end user (col 3, lines 51-59); and
- c. Providing a transaction (billing) statement to the end user (col 3, lines 19-27).

While Bucci does not explicitly disclose providing prompts to the end user, receiving end user data; and storing the end user data, Official Notice is taken that it is old and well known to

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collect such information from the end user. For example, when signing up for such a billing service, the end user would usually be required to complete an application form by filling in the blanks with the appropriate personal information - - name, mailing address, telephone number, account numbers of selected merchants/utilities, etc. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to prompt the end user to provide the information and to store the information once it was received from the end user. One would have been motivated to get the information directly from the end user and to store the information in order to ensure the most correct, up-to-date information is entered into the system and to preclude the need for the end user to reenter the information each time the billing system is run.

Bucci also does not explicitly disclose that the targeted messages are reminders, tips, or suggestion for any heath-related topic. Byerly disclose a similar system and method for providing personalized messages to end users in which the messages are "a greeting, a doctor's appointment reminders, billing information, promotional material, information concerning related products, discounts, coupons, government warnings, and news items" (col 6, lines 31-36). Thus, the end user is provided with both billing information and reminders, tips or suggestions for any health-related topic. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide these types of health-related messages as Bucci's targeted messages. One would have been motivated to include health-related messages, such as an

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advertisement for a new health supplement, in view of Bucci's disclosure that the messages could be advertising or other hard-copy material.

Claims 61, 62, 69, 70, 104, 105, 112, and 113: Bucci and Byerly disclose a system and method for providing personalized messages to an end user as in Claims 60 and 103 above. While neither reference discloses that the prompts include headings, questions, information, or guidelines that enable the end user to enter personal, health-related, demographic, or preference information, Official Notice is taken that it is old and well known for application forms to include such features. An example of such an application form is the Patent Office form that the Applicant filled in and submitted with the present Application. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to present such features to the end user in Bucci when collecting the user data. One would have been motivated to use features, such as headings, questions, information, or guidelines, on the application form in order to provide the end user with completion instructions to ensure that the desired information is collected. The Examiner notes that any type of desired information may be collected from the end user in this manner. The exact information, whether, personal demographics, preferences, health-related, or otherwise, does not change the method of collecting the data from the end user.

Claims 63, 64, 106, and 107: Bucci and Byerly disclose a system and method for providing personalized messages to an end user as in Claims 60 and 103 above. The inclusion of headings, questions, information, and guidelines as types of prompts has been discussed in the rejection of Claims 61, 62, 104, and 105 above. Bucci explicitly discloses the inclusion of non-

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health related information as personalized messages (col 3, lines 52-59), and Byerly discloses the inclusion of either health-related or non-health related information as personalized messages (col 6, lines 32-36). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the personalized messages could pertain to any subject matter, whether health-related or not. One would have been motivated to include any type of information in the personalized messages in order to broaden the utility of the invention.

Claims 65, 66, 108, and 109: Bucci and Byerly disclose a system and method for providing personalized messages to an end user as in Claims 60 and 103 above. While neither reference explicitly discloses that the prompts can be added, modified, revised, or deleted by and desired party, Official Notice is taken that it is old and well known to incorporate such features into data collection systems. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the application form to be altered or deleted based on the desires of the system operator. One would have been motivated to allow such changes to be made in order to allow the system to “grow” and “adapt” to changing business situations and to react to the desires of new “subscribers” in Bucci.

Claims 67, 68, 73, 74, 86-89, 94, 110, 111, 116, 117, 129-132, and 137: Bucci and Byerly disclose a system and method for providing personalized messages to an end user as in Claims 60 and 103 above. Bucci also discloses receiving the end user information from third parties through electronic (e.g. Internet) and hard-copy means (col 2, lines 55-63).

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Claims 71, 72, 114, and 115: Bucci and Byerly disclose a system and method for providing personalized messages to an end user as in Claims 60 and 103 above. While neither reference explicitly discloses allowing the end user information to be added, modified, revised, or deleted, Official Notice is taken that it is old and well known within data collection systems to allow the stored data to be added, modified, revised, or deleted. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the end user information being stored in Bucci to be added, modified, revised, or deleted. One would have been motivated to allow such manipulation of the end user data in order to allow the system to grow (add new end users), to keep up-to-date by incorporating new addresses, telephone numbers, and other information about an end user, and to expunge end user information once the end user is no longer participating in the system (e.g. the end user died). The Examiner notes that these are normal features found in every database management system.

Claims 75-78 and 118-121: Bucci and Byerly disclose a system and method for providing personalized messages to an end user as in Claims 60 and 103 above. Bucci also discloses that the messages may be personalized to the individual end user or include more general generic information (col 3, lines 51-58).

Claims 79 and 122: Bucci and Byerly disclose a system and method for providing personalized messages to an end user as in Claims 60 and 103 above. While neither reference explicitly discloses that the end user may acknowledge the receipt of the reminder, tip, or suggestion, Official Notice is taken that it is old and well known within the marketing arts to

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provide means for end users to acknowledge receipt of information, offers, billing statements, etc. Examples of known acknowledgment methods include providing a prepaid return postcard in the envelope, sending the information with a US Post Office Return Receipt form attached to the item, signing a receipt (such as used by FedEx, UPS, and the court system when serving summons), etc. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the end user in Bucci with a means to acknowledge receipt of the personalized message. One would have been motivated to provide the end user with an acknowledgment means in order to allow the system to better track the consumer's buying patterns as discussed by Bucci (col 3, lines 52-54).

Claims 80, 81, 123, and 124: Bucci and Byerly disclose a system and method for providing personalized messages to an end user as in Claims 60 and 103 above. Bucci further discloses providing the billing statement and messages to end user information through any communicative embodiment (col 3, lines 19-23).

Claims 82-85 and 125-128: Bucci and Byerly disclose a system and method for providing personalized messages to an end user as in Claims 60 and 103 above. Bucci further discloses that the personalized message may appear directly on the same page as the billing statement, on a part of the page which can be detached from the billing statement, or as a separate enclosure in the same or difference mailing (col 3, lines 19-21 and 55-67).

Claims 90 and 133: Bucci and Byerly disclose a system and method for providing personalized messages to an end user as in Claims 60 and 103 above. While neither reference

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explicitly discloses the method comprising disclaimers, the examiner interprets this to mean that the personalized message is a disclaimer, such as "The billing entity assumes no liability for the authenticity of the information provided" or some similar message as is standard practice. As previously noted to the Applicant, the exact nature of the information being provided, i.e. the content of the personalized message, is given no patentable weight. When the reference disclose sending messages to the end user, it is inherent that any information can be included in that message, depending on the desires of the sender. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a disclaimer with the personalized messages, especially if it was health-related. One would have been motivated to provide a disclaimer when sending a health-related message in order to prevent the end user from suing the billing service if the message causes harm to the end user.

Claims 91, 92, 134, and 135: Bucci and Byerly disclose a system and method for providing personalized messages to an end user as in Claims 60 and 103 above. The Examiner interprets these claims as being directed to end users who are not financial cardholder, but who receive billing statements from some other entity (e.g. utility company) with the personalized message (health-related or not) included with the billing statement. As such, Bucci discloses that the billing statements are received from a wide variety of billing entities and are not limited to financial card entities (See Table I).

Claims 93 and 136: Bucci and Byerly disclose a system and method for providing personalized messages to an end user as in Claims 60 and 103 above. While neither reference

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explicitly discloses that the system and method will be advertised to the general public, Official Notice is taken that it is old and well known within the marketing art to advertisement ones products or services to the general public. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to advertisement the Bucci system to the general public. One would have been motivated to advertise the system in this manner in order to attract more end users to the system, thus enhancing the financial viability of the system.

Claims 95 and 138: Bucci and Byerly disclose a system and method for providing personalized messages to an end user as in Claims 60 and 103 above. While it is not explicitly disclosed that the financial card entity will provide financial disbursement to cardholder for such things as health related matters, Official Notice is taken that it is old and well known within the marketing arts for financial institutions such as banks, credit unions, and other credit entities to pay for health, disability and/or life insurance premiums of their members. It is also well known for financial card entities to provide rebates to their cardholders based on their usage of the card (e.g. Discover card's cash back program). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the financial card entity to not only give the cardholders rebates, but to use the rebate to pay for health-related matters. One would have been motivated to pay for this type of items in order to entice new members to join and to provide protection to the financial card entity for monies due in case the cardholder becomes ill, disabled, or dies.

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Claims 96 and 139: Bucci and Byerly disclose a system and method for providing personalized messages to an end user as in Claims 60 and 103 above. These claims include the feature of providing memorials to the end user, wherein the memorial may be a monument or a website. The Examiner is interpreting this to mean that the end user receives a message directing him to a business or website which will allow the end user to leave a personal “memorial” message. As previously discussed, the content of the personalized message being delivered to the end user does not affect the method being used to deliver the message to the end user. Therefore, no patentable weight is given to the content of the message. Since Bucci discloses that the personalized message could be an advertisement, it is obvious that the advertisement could direct the end user to one of the claimed “memorializing” entities or to any other location or entity desired.

Claims 97 and 140: Bucci and Byerly disclose a system and method for providing personalized messages to an end user as in Claims 60 and 103 above. While neither reference explicitly discloses that the financial card entity will set up medical appointments on behalf of the end user, Official Notice is taken that automatic scheduling systems are old and well known within the art. For example, Goldstein (2001/0021910) discloses a method for providing “scheduling and coordinating pre and post-operative appointments and procedures between patients and medical practitioners” (Abstract); Mozayeny et al (2002/0035495) discloses a method for scheduling and coordinating appointment which additionally automatically notifies the patient of delays or cancellation and reschedules the appointment (col 6, paragraph 0066); and

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Levine (5,093,813) discloses a method for making appointments which notifies the patient of open days, time slots, etc. (Abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to not only notify the end user of a pending appointment or that it was time for an appointment, but also to include the mechanism to automatically make the appointment for the end user in Bucci. One would have been motivated to include the appointment-making mechanism in view of the disclosure in Bucci that the personal information about the end user in the database could include medical data.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

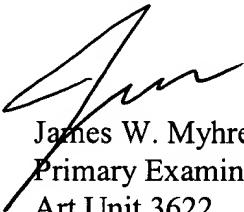
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.


JWM
June 17, 2003


James W. Myhre
Primary Examiner
Art Unit 3622